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## REMARKS

This is intended as a full and complete response to the Final Office Action dated September 22, 2005, having a shortened statutory period for response set to expire on December 22, 2005. Claims 1-3, 5-36, and 39-41 are pending in the application. Please reconsider the claims pending in the application for reasons discussed below.

### Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a). According to the Examiner, the mating of the back bearing body with the piston must be shown or the feature cancelled from the claims. In response, Applicants respectfully direct the Examiner to Figure 5 where it clearly shows the back bearing body "315" mated to the piston "240". Therefore, Applicants respectfully request the objection to the drawings be removed.

### Claim Rejections Under 35 U.S.C. § 102 (b)

The Examiner rejected Claims 39 and 40 as being anticipated by *Simpson* '532. Additionally, the Examiner rejected claim 39 as being anticipated by *Clark* '891. Applicants have cancelled claims 39 and 40, thereby obviating the rejection.

### Claim Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 15, 29, and 33 as being obvious over *Simpson* '532 in view of *Clark* '630 and the pre-grant publication '704 to *Jackson*. Applicants respectfully traverse the rejection.

As correctly indicated by the Examiner, *Simpson* in view of *Clark* does not disclose that the bearing member is matable to the roller to prevent relative rotation between the two, or that there is a cooling channel disposed between the bearing member. As such, the Examiner attempts to supplement this missing limitation by using *Jackson*. According to the Examiner, it is common in the art of bearings to mate the bearing in relation to one surface if the bearing is in contact with another surface and to place a cooling channel between the bearing surfaces. However, in order to establish a

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*prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. As persons skilled in the art of expander tools would recognize, Applicants' invention of an expander tool is different and distinct from the art of bearings. Moreover, there is no suggestion or motivation, either in the references (*Simpson, Clark, Jackson*) themselves or in knowledge generally available to one of ordinary skill in the art, to combine prior art teachings about expander tools with a prior art teaching about bearings. Without a motivation to combine, *Simpson* and/or *Clark* and/or *Jackson* do not render claims 1, 15, 29 and 33 obvious.

Further, *Jackson* does not constitute analogous art and therefore was improperly relied on by the Examiner. First, *Jackson* is not in the same field of endeavor as Applicants' invention. The primary subject matter of the Applicants' invention is an expander tool for use in expanding a string of casing. By contrast, the subject matter of *Jackson* is a thrust washer assembly for a vehicle torque converter. Since the device taught by *Jackson* serves a completely different purpose than Applicants' expander tool, one skilled in the art would recognize these inventions to be in different fields of endeavor. Second, *Jackson* is not at all relevant to the particular problem solved by Applicants' invention. The specification is clear that the Applicants' invention addresses certain limitations found in prior art expander tools. By contrast, *Jackson* provides an assembly that can be used in a torque converter, such as an automotive transmission system. As persons skilled in the art would recognize, the problem addressed by *Jackson* has no relation to the problem addressed by Applicants' invention. For these reasons, Applicants contend that *Jackson* constitutes nonanalogous art, thereby making the Examiner's reliance on *Jackson* in the § 103(a) rejection of claims 1, 15, 29, and 33 impermissible.

Additionally, the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a separate bearing surface that is mated to the piston, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art *Nerwin v. Erlichman*, 168 USPQ 177, 179. Generally, *Nerwin v. Erlichman* is used to illustrate

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that cutting something in half and then attaching the two parts is obvious. However, *Nerwin v. Erlichman* appears not to speak to formerly integral structures where splitting such structures includes improving them as in the present case where separating the bearings from the roller results in the capability of the use of variable materials.

For the reasons discussed herein, the combination of *Simpson* and *Clark* and *Jackson* do not render claims 1, 15, 29, and 33 obvious. Applicants therefore submit that claims 1, 15, 29 and 33 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection. Additionally, claims 2, 3, 5, 6, 10 and 11 depend from claim 1, claims 16-19 and 41 depend from claim 15, claims 30-31 depend from claim 29 and claims 34-36 depend from claim 33 and they are allowable for at least the same reasons as claims 1, 15, 29, and 33.

The Examiner rejected claims 7-9 and 32 as being obvious over *Simpson* '532 in view of *Clark* '630 and *Jackson* '704 as applied to claims 5, 15, 30, and 35 above, and further in view of the pre-grant publication '769 to *Whang*. Applicants respectfully traverse the rejection.

According to the Examiner, it would have been obvious to one of ordinary skill in the art (the bearing art) at the time the invention was made to place the grooves of *Whang* '769 on the thrust bearing of *Simpson* '532 in view of *Clark* '630 and *Jackson* '704 in order to preserve the thrust bearing as taught by *Whang* '769. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. As persons skilled in the art of expander tools would recognize, Applicants' invention of an expander tool is different and distinct from the art of bearings. Moreover, there is no suggestion or motivation, either in the references (*Simpson*, *Clark*, *Jackson*, *Whang*) themselves or in knowledge generally available to one of ordinary skill in the art, to combine prior art teachings about expander tools with a prior art teaching about bearings. Without a motivation to combine, *Simpson* and/or *Clark* and/or *Jackson* and/or *Whang* do not render claims 7-9 and 32 obvious.

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Further, *Whang* does not constitute analogous art and therefore was improperly relied on by the Examiner. First, *Whang* is not in the same field of endeavor as Applicants' invention. The primary subject matter of the Applicants' invention is an expander tool for use in expanding a string of casing. By contrast, the subject matter of *Whang* is an oil lubricated sliding bearing. Since the device taught by *Whang* serves a completely different purpose than Applicants' expander tool, one skilled in the art would recognize these inventions to be in different fields of endeavor. Second, *Whang* is not at all relevant to the particular problem solved by Applicants' invention. The specification is clear that the Applicants' invention addresses certain limitations found in prior art expander tools. By contrast, *Whang* provides an oil lubricated sliding bearing for reducing frictional resistance. As persons skilled in the art would recognize, the problem addressed by *Whang* has no relation to the problem addressed by Applicants' invention. For these reasons, Applicants contend that *Whang* constitutes nonanalogous art, thereby making the Examiner's reliance on *Whang* in the § 103(a) rejection of claims 7-9 and 32 impermissible.

For the reasons discussed herein, the combination of *Simpson* and *Clark* and *Jackson* and *Whang* do not render claims 7-9 and 32 obvious. Applicants therefore submit that claims 7-9 and 32 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection.

The Examiner rejected claim 20 as being obvious over *Simpson* '532 in view of *Clark* '630 and *Jackson* '704 as applied to the claims above, and further in view of the WIPO document '728 to *Simpson, et al.* Applicants respectfully traverse the rejection.

The Examiner explains in the rejection that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a bearing between the adjacent rollers of *Simpson* '532 in view of *Clark* '630 and *Jackson* '704 and WIPO '728 because the Examiner takes official notice that whenever two surfaces are in sliding engagement adjacent each other a thrust bearing is often used as a means of protection, as in the case with the current apparatus between the roller and the piston.

MPEP 2143.03 provides:

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"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Further, MPEP 2144.04(B) provides:

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

Finally, MPEP 2144.04(C) provides:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

As set forth above, the Examiner cannot merely state that it would have been obvious to place a bearing between adjacent rollers because there is a thrust washer between a roller and a piston with no evidence as to why it would be obvious to do so. A general rationale that "it is well known" without some teaching in the prior art is a

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rationale based on impermissible hindsight and is not permitted within the confines of 35 U.S.C. § 103. Further, as set forth above, there is no motivation to combine *Simpson*, *Clark*, and *Jackson*. Additionally, as set forth above, *Jackson* constitutes nonanalogous art, thereby making the Examiner's reliance on *Jackson* in the § 103(a) rejection impermissible.

For these reasons, the combination of *Simpson* and *Clark* and *Jackson* and WIPO '728 do not render claim 20 obvious. Applicants therefore submit that claim 20 is in condition for allowance and respectfully request withdrawal of the § 103(a) rejection. Additionally, claims 12 and 13 depend from claim 1 and claims 21-25 depend from claim 20 and they are allowable for at least the same reasons as claims 1 and 20.

The Examiner rejected claims 26-28 as being obvious over *Simpson* '532 in view of *Clark* '630, *Jackson* '704, and WIPO '728 as applied to claim 24 above, and further in view of *Whang* '769. Applicants respectfully traverse the rejection. As set forth above, there is no motivation to combine *Simpson*, *Clark*, and *Jackson*. Further, as set forth above, *Jackson* and/or *Whang* '769 constitutes nonanalogous art, thereby making the Examiner's reliance on *Jackson* and/or *Whang* '769 in the § 103(a) rejection impermissible. Furthermore, claims 26-28 depend from claim 20 and is allowable for at least the same reasons as claim 20. For these reasons, Applicants therefore submit that claims 26-28 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection.

#### Conclusion

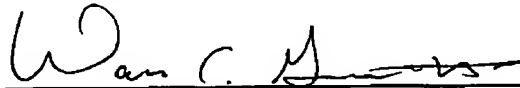
In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

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Having addressed all issues set out in the Final Office Action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

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